

REMARKS

In the Final Office Action,¹ the Examiner rejected claims 1-15 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,914,701 to Gersheneld et al. ("*Gersheneld*").

By this Amendment, Applicant propose to amend claims 1, 7, 8, 14, and 15 to more appropriately define the invention. The amendments to the claims are fully supported by the original disclosure. See, e.g., specification, FIG. 8. Applicant respectfully traverses the rejection and requests reconsideration and allowance of the pending claims for at least the following reasons.

Rejection of Claims 1-15 under 35 U.S.C. § 102(b)

Applicant respectfully traverses the rejection of claims 1-15 under 35 U.S.C. § 102(b) as being anticipated by *Gersheneld*. In order to properly establish that *Gersheneld* anticipates Applicant's claimed invention under 35 U.S.C. § 102, each and every element of each of the claims in issue must be found, either expressly described or under principles of inherency, in that single reference. Furthermore, "[t]he identical invention must be shown in as complete detail as is contained in the ... claim." See M.P.E.P. § 2131, quoting *Richardson v. Suzuki Motor Co.*, 868 F.2d 1126, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989). *Gersheneld* does not disclose each and every element of Applicant's claimed invention.

¹ The Final Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicant declines to automatically subscribe to any statement or characterization in the Final Office Action.

Independent claim 1, as proposed to be amended, calls for a combination including, for example, “quasi-electrostatic field detecting means compris[ing] a [] pair of electrodes both formed on a same insulating sheet” (emphasis added). *Gersheneld* fails to teach or suggest at least this element.

The Office asserted that the pair of electrodes 24 and 26 of *Gersheneld* correspond to the claimed “pair of electrodes [of said quasi-electrostatic field detecting means].” See Final Office action, p. 4. Without acquiescing to this assertion, Applicant respectfully submits that *Gersheneld* explicitly teaches that the pair of electrodes 24 and 26 are an inner electrode facing the user and an outer electrode facing away from the user, respectively. See, e.g., *Gersheneld*, col 4, ll. 55-59, and FIG. 2. There is no teaching or suggestion in *Gersheneld* that these two electrodes are “both formed on a same insulating sheet.”

In view of the above, *Gersheneld* does not teach or suggest at least “quasi-electrostatic field detecting means compris[ing] a [] pair of electrodes both formed on a same insulating sheet” as recited in claim 1 (emphasis added). Accordingly, *Gersheneld* cannot anticipate claim 1, and claim 1 is allowable.

Independent claim 14, although different in scope from independent claim 1, recites elements similar to claim 1. Therefore, for reasons similar to those discussed above with respect to claim 1, claim 14 is allowable. Claims 2-7 are also allowable at least by virtue of their dependence from claim 1.

Independent claim 8, as proposed to be amended, calls for a combination including, for example, “detecting, by a pair of electrodes both arranged facing said object via a same insulating sheet, a result of interaction between said quasi-

electrostatic field and an electric field corresponding to a potential change caused by a dynamic reaction inside said object” (emphasis added). *Gersheneld* fails to teach or suggest at least this element.

As discussed above in regard to the rejection of claim 1, even if *Gersheneld* could be reasonably argued to teach a pair of electrodes comprised in a detector, which Applicant does not concede, *Gersheneld* nevertheless explicitly teaches that one of the pair of electrodes 24 and 26 is facing away from the user. See, e.g., *Gersheneld*, col. 4, ll. 55-59, and FIG. 2. Moreover, there is no teaching or suggestion in *Gersheneld* of separating both electrodes 24 and 26 from the user using a same insulating sheet.

In view of the above, *Gersheneld* does not teach or suggest at least “detecting, by a pair of electrodes both arranged facing said object via a same insulating sheet, a result of interaction between said quasi-electrostatic field and an electric field corresponding to a potential change caused by a dynamic reaction inside said object” as recited in claim 8 (emphasis added). Accordingly, *Gersheneld* cannot anticipate claim 8, and claim 8 is allowable.

Independent claim 15, although different in scope from independent claim 8, recites elements similar to claim 8. Therefore, for reasons similar to those discussed above with respect to claim 8, claim 15 is allowable. Claims 9-13 are also allowable at least by virtue of their dependence from claim 8, respectfully.

Therefore, Applicant respectfully requests that the Examiner reconsider and withdraw the rejection of claims 1-15 under 35 U.S.C. § 102(b).

CONCLUSION

Applicant respectfully requests that this Amendment under 37 C.F.R. § 1.116 be entered by the Examiner, placing claims 1-15 in condition for allowance. Applicant submits that the proposed amendments of claims 1, 7, 8, 14, and 15 do not raise new issues or necessitate the undertaking of any additional search of the art by the Examiner, since all of the elements and their relationships claimed were earlier claimed or inherent in the claims as examined. Therefore, this Amendment should allow for immediate action by the Examiner.

Furthermore, Applicant respectfully points out that the final action by the Examiner presented some new arguments as to the application of the art against Applicant's invention. It is respectfully submitted that the entering of the Amendment would allow the Applicant to reply to the final rejections and place the application in condition for allowance.

Finally, Applicant submits that the entry of the amendment would place the application in better form for appeal, should the Examiner dispute the patentability of the pending claims.

In view of the foregoing remarks, Applicant submits that this claimed invention, as amended, is neither anticipated nor rendered obvious in view of the prior art references cited against this application. Applicant therefore requests the entry of this Amendment, the Examiner's reconsideration and reexamination of the application, and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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